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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,359	12/06/2000	John H. Jebens	29544/36981	8464

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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3694

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,359

Applicant(s)

JEBENS ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-112 and 121-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 104-112 and 121-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 104-112 and 121-126 are pending. Claims 104 and 122 have been amended in this communication filed 09/25/06 entered as Request For Extension of Time, Response After Non-Final Action, and New or Additional Drawings. The IDS filed 10/11/05 has been considered and entered.
2. The Notice of Non-Compliant Amendment (37 CFR 1.121) has been overcome by Applicants' amendment and resubmission of the drawings in compliance with 37 CFR 1.121 and is hereby withdrawn.
3. The Objection to the Specification has been overcome by the submission of a Substitute Specification and is hereby withdrawn.
4. The 35 USC 112 second paragraph rejections for claims 104, 108, 121, 122, and 125 have been withdrawn in view of the Applicants' convincing argument. However, claims 108, 111, 112, and 124 still remain rejected under 35 USC 112 second paragraph as set forth here below.

Claim Objections

5. Claim 104, line 23 is objected in view of the amendment to the claim because of the following informalities: Claim 104 recites "means for electronically routing the one of the ...to a". This line should recite "means for electronically routing one of the ... to a". Claims 111, 123, and 126 are in improper method claim format. Claims 111 in the last claim limitation recites "automatically electronically routing ...". This claim limitation should recite "routing automatically electronically ...". Claim 123 in limitations four and

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six and claim 126 in limitations three and five have a similar problem. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 108, 111, 112, and 121-126 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: claim 108, page 3, lines 11 and 12 "... subset of the digital images to the first image provider". Claim 112 has a similar problem on page 4, line 7 and page 5, line 3; claim 124, page 7, lines 7 and 10 and page 8, line 5. Claim 111, page 4, lines 8 and 9 "the high resolution and low resolution copy of the digital image provided by the first image provider, the second digital image being transparent to the first image provider. Claims 121-123, 125, and 126 have similar 35 USC 112 issues.

Claims 104, 107, 109, and 110 are also rejected because of their dependency from a rejected base claim.

Response to Arguments

8. Applicant's arguments filed 09/25/06 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: The Office Action rejects claims 108, 111, 112, and 124 on page 5 as being incomplete for omitting essential elements, such omission amounting to a gap between the elements' and the Applicants' respectfully traverse this

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rejection has been considered but is not persuasive. Response: Claim 108 lines 11 and 12 recite "provider ... copies of the subset to the first image provider". This recitation leaves the reader wondering at to "subset" of what "to the first image provider". This line should recite "provider ... copies of the subset of the digital images to the first image provider". Claims 111, 112, and 124 still have a similar problem as rejected under 35 USC 112 second paragraph.

Issue no. 2: Applicants' argue: Fredlund does not teach or suggest the capability to identify additional authorized users and Morris does not disclose a sharing system in which the image provider may identify additional authorized users has been considered but is not persuasive. Response: Applicants' argument "may identify" is not a positive argument recitation and if it were to be incorporated into the claim limitations would result in a 35 USC 112 second paragraph rejection. Further, the "identifying additional authorized users" and "a sharing system in which the image provider identifies additional authorized users" is not interpreted as being disclosed or suggested in the claim limitations of the rejected claims.

Applicants' have 35 USC 112 second paragraph problems in the claims and the application cannot be issued until these issues are resolved.

Inquiries

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 7, 2006


ELLA COLBERT
PRIMARY EXAMINER